

Applicants: Nils Ove Gustavsson, *et al.*  
U.S. Serial No.: 10/705,204  
Filed: November 10, 2003  
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Docket No.: 28069-551B-CON  
(Formerly: 49458/60049 CON)

### **REMARKS/ARGUMENTS**

In this Amendment, claims 1-5, 7-18, 20-28 and 48 are currently amended and claims 6, 19, 29-47 and 49 are canceled without prejudice or disclaimer. Claims 50-66 are newly added. No new matter has been introduced into the application by virtue of the amended and new claims. A number of the currently amended claims contain formalistic changes to the claim language.

Support for the amended and new claims is found throughout the specification of the application as filed, and in the original and previously filed claims.

Accordingly, claims 1-5, 7-18, 20-28, 48 and 50-66 are currently pending in the application.

The Examiner has requested that Applicant forward the claims of pending application U.S. Serial No. 09/970,649 so that he may review them for double patenting issues. Accordingly, Applicants provide a listing of the claims as currently pending in the '649 application in compliance with the Examiner's request.

### **Double Patenting**

Claims 1-28 were provisionally rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1-23 and 25-29 of co-pending patent application U.S. Serial No. 10/162,674 ("the '674 application").

It is respectfully submitted that claims 1-40 of the co-pending '674 application have been canceled without prejudice in that application, thereby mooted the provisional double patenting rejection.

Claim 29 was provisionally rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claim 31 of co-pending patent application U.S. Serial No. 10/627,920.

It is submitted that the cancellation without prejudice or disclaimer of claim 29 herein moots this rejection. Withdrawal of this §101 double patenting rejection is thus respectfully requested.

Claims 29, 31-47 and 39 were rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1-19 of prior U.S. Patent No. 6,692,770.

It is submitted that the cancellation without prejudice or disclaimer of claims 29-47 herein moots this rejection. Withdrawal of this §101 double patenting rejection is thus respectfully requested.

Claims 1-28 were rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1-28 of prior U.S. Patent No. 6,706,288 (hereinafter "the '288 patent").

It is submitted that the presently amended claims, (i.e., claim 1 and the claims depending from claim 1, which contain all of the patentable features of claim 1 in addition to the subject matter described therein), are distinct from patented claims 1-28 of the '288 patent.

In particular, in the instant application, presently amended claim 1 describes a process for producing parenterally administrable microparticles in which the steps of the process are not identical to those of claim 1 of the '288 patent. For example, in presently amended claim 1 in the instant application, step a) of the method describes a starch which, among other characteristics, essentially lacks covalently bonded hydroxyethyl groups. Also, in step c) of presently amended claim 1 in the instant application, the polymer solution is added to the composition in at least two steps, in which at least one of the additions occurs after the

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emulsion has begun to be created. Thus, claim 1 of the instant application and claim 1 of the '288 patent do not claim identical inventions. Because all of the dependent claims in the instant application depend either directly or indirectly from claim 1, these dependent claims and claims 2-28 of the '288 patent also do not claim the same invention. Accordingly, withdrawal of the §101 double patenting rejection is respectfully requested.

Claim 48 is objected to as being dependent on a rejected base claim. It is submitted that claim 48, as presently amended, along with presently amended claims 1 and 2, upon which claim 48 depends, overcome the objection.

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### CONCLUSION

Applicants respectfully submit that this application is now in condition for allowance. An action progressing this application to issue is courteously urged.

Should any additional fees be deemed to be properly assessable in this application for the timely consideration of this amendment and response, or during the pendency of this application, the Commissioner is hereby authorized to charge any such additional fee(s), or to credit any overpayment, to Deposit Account No. **50-0311**, Reference No. **28069-551B-CON**, Customer No. **34537**.

If the Examiner believes that further discussion of the application would be helpful, he is respectfully requested to telephone the undersigned at (212) 692-6742 and is assured of full cooperation in an effort to advance the prosecution of the instant application and claims to allowance.

Respectfully submitted,

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AND POPEO, P.C.

Date: January 18, 2005

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